

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEROME S. BERG

Appeal No. 98-2520
Application 08/613,792¹

ON BRIEF

Before FRANKFORT, McQUADE and BAHR, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed March 1, 1996.

Appeal No. 98-2520
Application 08/613,792

This is a decision on appeal from the examiner's final rejection of claims 1 through 4, 6 through 27 and 29.²

Claim 5

has been canceled. Claim 28 stands objected to, but has been indicated by the examiner to be allowable if rewritten in independent form.

Appellant's invention is directed to a lightweight shaft of composite construction, a golf club which utilizes said lightweight shaft, and a method of making said lightweight shaft. Claims 1, 17, 23, 24, 25 and 29 are representative of the subject matter on appeal and copies of those claims appear in the Appendix to appellant's brief.

The prior art references relied upon by the examiner in rejecting the appealed claims are:

Roy	4,889,575	Dec. 26, 1989
Noguchi	5,385,767	Jan. 31, 1995
Kusumoto	5,427,373	June 27, 1995
Akatsuka et al. (Akatsuka)	5,437,450	Aug. 1, 1995

² Claim 29 was amended subsequent to the final rejection in a paper filed February 18, 1998 (Paper No. 10).

Appeal No. 98-2520
Application 08/613,792

Nagamoto et al. (Nagamoto)	5,454,563	Oct. 3, 1995
Billings	5,547,189	Aug. 20, 1996
		(filed July 20,
1994)		

Claims 1 through 4, 6 through 10, 12 through 14, 17 through 19 and 21 through 24 stand rejected under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka.

Claims 11 and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka as applied above and further in view of Noguchi.

Claim 15 stands rejected under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka as applied above and further in view of Roy.

Claim 16 stands rejected under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka as applied above and further in view of Nagamoto.

Appeal No. 98-2520
Application 08/613,792

Claim 25 stands rejected under 35 U.S.C. § 103 as being unpatentable over Roy in view of Billings, Kusumoto and Akatsuka.

Claims 26 and 27 stand rejected under 35 U.S.C. § 103 as being unpatentable over Roy in view of Billings, Kusumoto and Akatsuka as applied above and further in view of Nagamoto.

Claim 29 stands rejected under 35 U.S.C. § 103 as also being unpatentable over Roy in view of Billings, Kusumoto and Akatsuka as applied above and further in view of Nagamoto.

Reference is made to the examiner's answer (Paper No. 15, mailed July 17, 1998) for the examiner's reasoning in support of the above-noted rejections and to the appeal brief (Paper No. 14, filed May 28, 1998) for appellant's arguments thereagainst.

OPINION

Appeal No. 98-2520
Application 08/613,792

Our evaluation of the obviousness issues raised in this appeal has included a careful assessment of appellant's specification and claims, the applied prior art references, and the respective positions advanced by appellant and the examiner. As a consequence of our review, we have come to the conclusion, for the reasons which follow, that the examiner's rejections of the appealed claims under 35 U.S.C. § 103 are not well founded and, therefore, will not be sustained.

Turning first to the examiner's rejection of claims 1 through 4, 6 through 10, 12 through 14, 17 through 19 and 21 through 24 under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka, we note that while Billings discloses a golf club wherein the shaft may be made of a composite material (col. 4, lines 59-63) and also provided with a

lightweight filler material located within an opening in the club body at or adjacent the tip end thereof (col. 5, lines 26-31), Billings makes no mention of the specific manner of

Appeal No. 98-2520
Application 08/613,792

construction for the composite shaft therein and provides no teaching or suggestion concerning any defined layered shaft structure like that set forth in the claims before us on appeal. Kusumoto and Akatsuka each disclose golf club shafts having a layered composite construction and, as noted by the examiner, disclose individual layers therein that are the same as or similar to certain of the individual layers used in appellant's claimed lightweight shaft and golf club. However, what each of the references relied upon by the examiner lacks is any teaching, suggestion or incentive for combining the particular types of reinforcing layers set forth in the claims on appeal in the particular sequence claimed so as to arrive at a lightweight shaft or golf club like that defined in appellant's claims on appeal.

Like appellant (brief, page 11), it is our opinion that the examiner has used the claimed invention as a guide or blueprint to piece together various disparate aspects of the Billings, Kusumoto and Akatsuka patents in an attempt to arrive

Appeal No. 98-2520
Application 08/613,792

at the claimed subject matter. In this regard, we consider that the examiner's proposed modifications of the golf club shaft in Billings to have the particular layers claimed by appellant arranged in the particular sequence claimed are based on hindsight reconstruction of the claimed subject matter using appellant's own teachings and disclosure. For that reason, we refuse to sustain the examiner's rejection of claims 1 through 4, 6 through 10, 12 through 14, 17 through 19 and 21 through 24 under 35 U.S.C. § 103 as being unpatentable over Billings in view of Kusumoto and Akatsuka.

Nor shall we sustain any of the examiner's other rejections under 35 U.S.C. § 103. We have carefully reviewed the patents to Noguchi, Roy and Nagamoto applied by the examiner in those other rejections, but find nothing therein which would provide for the teachings and/or suggestions which we have already determined to be lacking in the examiner's stated combination of Billings, Kusumoto and Akatsuka. Moreover, we generally share appellant's view that each of the additional rejections posited by the examiner is also based on

Appeal No. 98-2520
Application 08/613,792

impermissible hindsight derived from appellant's own disclosure and not on the fair teachings or suggestions of the prior art itself as such would have been understood by one of ordinary skill in the art at the time of appellant's invention.

It is well settled that a rejection based on § 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of supplying the factual basis for the rejection he advances. He may not, because he doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

Appellant's brief, at pages 12 through 14, makes reference to a declaration by David Hallford (copy attached to the brief as Exhibit A), which declaration purports to

Appeal No. 98-2520
Application 08/613,792

establish commercial success of the claimed invention.
However, in view of our disposition of the obviousness
rejections noted above, we find no need to review this
declaration.

As should be apparent from the foregoing, we have
refused to sustain any of the rejections before us on appeal.
Thus the decision of the examiner rejecting claims 1 through
4, 6 through 27 and 29 of the present application is
reversed.

REVERSED

	CHARLES E. FRANKFORT)	
	Administrative Patent Judge)	
)	
)	
)	BOARD OF
PATENT)	
	JOHN P. McQUADE)	APPEALS AND

Appeal No. 98-2520
Application 08/613,792

	Administrative Patent Judge)
INTERFERENCES)
)
)
	JENNIFER BAHR)
	Administrative Patent Judge)

CEF:psb

Appeal No. 98-2520
Application 08/613,792

J. Bruce Hoofnagle
Patent Department TW199
The Black & Decker Corporation
701 East Joppa Road
Towson, MD 21286